

REMARKS

I. General Remarks and Disposition of the Claims

Please consider the application in view of the following remarks. Applicants thank the Examiner for his careful consideration of this application, including the references that Applicants have submitted in this case.

Claims 1-12 and 25-32 are pending in this application. Claims 1, 3-11, and 25-32 stand rejected. Claim 2 is objected to. Claims 1 and 32 have been amended herein. These amendments are supported by the specification as filed. All the amendments are made in a good faith effort to advance the prosecution on the merits of this case. It should not be assumed that the amendments made herein were made for reasons related to patentability. Applicants respectfully request that the above amendments be entered and further request reconsideration in light of the amendments and remarks contained herein.

II. Remarks Regarding Rejections Under 35 U.S.C. § 102

Claims 1, 3-11, and 26-32 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,366,643 issued to Walker (hereinafter "*Walker*"). With respect to this rejection, the Office Action states:

With respect to claims 1 and 32, Walker discloses a method of inhibiting corrosion of a metal surface contacted by an aqueous acid solution comprising: combining a corrosion inhibiting composition with the aqueous acid solution and contacting the metal surface such as a metal surface in a subterranean formation, with the aqueous acid solution containing the corrosion inhibiting composition (see col. 1, lines 15-20). The corrosion inhibiting composition comprising the reaction product of an alpha,beta-unsaturated aldehyde with a primary or secondary amine (see col. 2, lines 30-67; see examples I-IV).

With respect to claim 3, Walker discloses that the metal surface comprises N-80 steel (see examples I-IV).

With respect to claim 4, Walker discloses that the alpha,beta-unsaturated aldehyde comprises cinnamaldehyde (see col. 5, lines 57-66).

With respect to claim 5, Walker discloses that the primary or secondary amine comprises ethanolamine (see table III).

With respect to claim 6, Walker discloses that the reaction product results from a reaction of the primary or secondary amine with the alpha,beta-unsaturated aldehyde at a molar ratio of amine

to aldehyde or ketone in the range of from about 0.1:1 to about 4:1. Specifically, Walker discloses 0.3 moles of ethanolamine and 0.66 moles of an aldehyde which fall within the claimed ratio (see example I and tables I-V).

With respect to claim 7, Walker discloses that the corrosion inhibiting composition is combined with the aqueous acid solution in an amount in the range of from about 0.01% to about 5% by weight of the aqueous acid fluid. Specifically, Walker discloses that the inhibitor composition is present in an amount from about 1 to about 20 gallons per 1000 gallons of aqueous acidic solution which falls within the claim range (see col. 8, lines 20-35).

With respect to claim 8, Walker discloses that the corrosion inhibiting composition further comprises a solvent or a surfactant (see col. 7, lines 40-60).

With respect to claims 9 and 10, Walker discloses that the aqueous acid solution is 15% hydrochloric acid. It is well known that a 15% solution of hydrochloric acid means that the solution is 15% hydrochloric acid and the remainder is water (see examples I-IV).

With respect to claims 11 and 25, Walker discloses in the examples that the metal coupon is exposed to the aqueous acid solution at temperatures of about 300°F, wherein the hydrochloric acid is at a concentration of about 15% by weight of the solution (see example I; see column 9).

With respect to claims 26-31, Walker discloses that the corrosion inhibiting composition may further comprise acetylenic alcohol (see col. 7, lines 1-24), carbonyl compounds (see col. 5, lines 10-25), and formamide (see table IV).

(Office Action at 2-4.) Applicants respectfully disagree. Applicants respectfully submit that the cited reference does not disclose each and every limitation of claims 1, 3-11, and 26-32, as required to anticipate these claims under 35 U.S.C. § 102(b). See MPEP § 2131.

In particular, with respect to independent claims 1 and 32, *Walker* fails to disclose a corrosion inhibiting composition comprising “a reaction product of an alpha,beta-unsaturated aldehyde or an alpha,beta-unsaturated ketone with a primary or secondary amine, the reaction product comprising a reaction product selected from the group consisting of an imine, a hemiaminal, an iminium ion, and combinations thereof.” Rather, the corrosion inhibitor disclosed in *Walker* is described as follows:

The corrosion inhibitor comprises the product of the reaction of (i) a compound having at least one reactive hydrogen atom and having

no groups reactive under the conditions of reaction other than hydrogen, (ii) a carbonyl compound having at least one hydrogen atom on the carbon atom adjacent to the carbonyl group, (iii) an aldehyde, (iv) a fatty compound and an acid source which is admixed with a source of antimony ions.

Walker, Abstract. As set forth in the Abstract, the corrosion inhibiting compositions disclosed in *Walker* are reaction products of at least four different reactants that will form different reaction products than required by Applicants' claims. See *Walker*, abstract; col. 2, line 49 - col. 3, line 4. As such, *Walker* fails to disclose a reaction product that comprises an imine, a hemiaminal, an iminium ion, or combinations thereof, as required by Applicants' claims as amended.

Therefore, Applicants respectfully assert that independent claims 1 and 32 and their dependent claims are not anticipated by *Walker*. Accordingly, Applicants respectfully request withdrawal of this rejection with respect to claims 1, 3-11, and 26-32.

III. Allowable Subject Matter

In the Office Action, the Examiner noted that claim 2 would be "allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims." (Office Action at 4.) Applicants gratefully acknowledge the Examiner's indication that claim 2 would be allowable if rewritten in independent form. Since Applicants have traversed the rejections of claim 1, which is the base claim of claim 2, Applicants respectfully submit that claim 2 is allowable.

IV. No Waiver

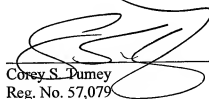
All of Applicants' arguments and amendments are without prejudice or disclaimer. By not responding to statements made by the Examiner, Applicants do not acquiesce to the Examiner's statements.

SUMMARY

In light of the above remarks, Applicants submit that the application is now in condition for allowance, and earnestly solicit timely notice of the same. Should the Examiner have any questions, comments or suggestions in furtherance of the prosecution of this application, the Examiner is invited to contact the attorney of record by telephone, facsimile, or electronic mail.

Applicants believe that there are no fees due in association with the filing of this Response. However, should the Commissioner deem that any fees are due, including any fees for extensions of time, Applicants respectfully request that the Commissioner accept this as a petition therefor, and direct that any additional fees be charged to the Deposit Account of Baker Botts L.L.P. (No. 02-0383, Order Number 063718.1313).

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Corey S. Tumey', is written over a horizontal line.

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